

REMARKS

In the office action dated January 3, 2003, claims 1-9, 11-13, 16-18 and 20 were rejected under 35 U.S.C. §103(a) as being unpatentable over Network World Journal in view of U.S. Pat. No. 5,732,127 (Hayes). The examiner did not indicate what she was referring to as the "Network World Journal" reference. However, since two separate references were listed on the form PTO-892 that come from a journal called "Network World," it is assumed that the examiner was referring to both of these references. Specifically, the two references are: International Equality, *Network World*, v. 13, n. 21, p. 6 (May 20, 1996) (hereinafter *Network World II*), and ISPs Target Remote Users, *Network World*, v. 13, n. 17, p. 16 (April 22, 1996) (hereinafter *Network World I*).

The *Network World I* reference is a one paragraph abstract that states the intention to provide an 800 telephone number that customers can use to access the Internet, and states that PSINet is offering an account management tool which allows IS personnel to manage accounts remotely. No details are provided.

The *Network World II* reference is a one paragraph abstract stating that the company plans to introduce a service that enables users in nine countries to dial a local number to gain access to the Internet. The reference also states that service charges for those countries will be integrated into the customer's regular bill. No details are provided.

The Hayes patent discloses a telecommunications switch for a mobile or cell phone system that allows billing records to be sent to an administrative center using a specified protocol. In Hayes, a local exchange 10A is connected to an administrative center 10C via one or more signal transfer points (STP) 90. The billing data is encapsulated in Data Form 2 (DT2) format and transmitted between the local exchange 10A and the administrative center 10C. The STP 90 provides the generation and transfer of signaling messages (col. 8, line 65 to col. 9, line 10). The local exchange 10A is a system that connects a mobile phone user to a public switched telephone network (PSTN) in a local geographic area (col. 3, line 25 to col. 4, line 34). The administrative center 10C is one of nodes supported by the STP 90 (col. 12, lines 30-31).

Claim 1 of the present invention claims a three-step method for accounting for services in an Internet access transaction. In the first step, a first server tracks the time a user is connected to

the Internet through a system operated by an Internet service provider (ISP) with whom the user does not have an account. In the second step, a user record is transmitted from the first server to a central settlement server, with the user record identifying the user and the amount of time the user was connected to the Internet. In the third step, the central settlement server generates a report from the user record, with the report including at least the amount of time the user was connected to the Internet. The report is provided to a second ISP with whom the first user does have an account.

Comparing claim 1 of the present invention to the *Network World I* and *Network World II* references shows that there are several differences between these inventions. First, the *Network World II* reference merely states that the company plans to introduce a service that enables users in nine countries to dial a local number to gain access to the Internet and that service charges for those countries will be integrated into the customer's regular bill. The *Network World I* reference merely mentions an account management tool without further description. Therefore, the *Network World I* and the *Network World II* references do not teach or suggest a method as is claimed in claim 1, where the user is connected to the Internet through a system operated by a first Internet Service Provider (ISP) with whom the user does not have an account; where a first server tracks an amount of time the user is connected to the Internet through the first system; where a user record is transmitted from the first server to a central settlement server; and where a report is generated by the central settlement server and provided to a second Internet Service Provider.

Comparing claim 1 of the present invention to Hayes shows that there are several differences between the two inventions. First, in the method of claim 1 the user is connected to the Internet through a system operated by a first Internet Service Provider (ISP). Second, claim 1 of the present invention states that the first server tracks an amount of time the user is connected to the Internet through the first system. Third, claim 1 states that the report is provided to a second Internet Service Provider. In contrast, Hayes does not disclose any of these steps because Hayes deals with a mobile phone system, not an Internet system. The hardware and software requirements of a mobile phone system are different from the requirements of an ISP as is illustrated by the extensive discussion in Hayes relating to prior art mobile phone systems and

protocols (Hayes, Figs. 2-9). Hence, there is no disclosure relating to the Internet or to ISPs in the Hayes patent.

Since the *Network World I* and *Network World II* references do not provide any disclosure at all relating to a method for accounting for services in an Internet access transaction, and since the Hayes patent relates solely to a mobile phone system, it cannot be said that combining these references would yield the invention of claim 1. A hypothetical inventor skilled in the art, with all of these references in hand, would not have a blueprint for how to make the invention of claim 1. Therefore, applicants respectfully submit that claim 1 is patentable over *Network World Journal* in view of Hayes.

Claims 2-5 are dependent on claim 1 and are therefore patentable over the *Network World Journal* in view of Hayes for the same reasons given above with respect to claim 1.

Claim 6 of the present invention claims a six-step method for accounting for services in an Internet access transaction. In the first step, a first server tracks the time a user is connected to the Internet through a system operated by an Internet service provider (ISP) with whom the user does not have an account. In the second step, a user record is transmitted from the first server to a second server located at a different location for storage, with the user record identifying the user and the amount of time the user was connected to the Internet. In the third step, the user record stored on the second server is transmitted to a central settlement server located at a different location. In the fourth step, the user record is stored in a database controlled by the central settlement server. In the fifth step, the central settlement server generates a report that includes an amount of money owed to the first ISP for the time the user used the first system to connect to the Internet. In the sixth step, the report is made available to a second ISP with whom the user does have an account.

Comparing claim 6 of the present invention to the *Network World I* and *Network World II* references, and to Hayes, shows that there are several differences between the two inventions. First, claim 6 includes similar distinguishing features to those described previously with respect to claim 1. Specifically, in claim 6 the user is connected to the Internet through a first system operated by a first ISP with whom the user does not have an account; the first server tracks an amount of time the user is connected to the Internet through the first system; and a report is

provided to a second ISP with whom the user does have an account.

Second, claim 6 includes the additional distinguishing feature of transmitting a user record to a second server located at a different physical location than the first server. The second server in claim 6 is different than the STP 90 disclosed in Hayes because the STP 90 is a signal transfer point, not a data storage site.

Third, in claim 6, the user record is transmitted from the second server to the central settlement server at selected intervals. Hayes does not teach this step. For all of these reasons, applicants submit that claim 6 is patentable over the Network World Journal in view of Hayes.

Claims 7-9, 11, 18 and 20 are dependent on claim 6 and are therefore patentable over the Network World Journal in view of Hayes for the same reasons given above with respect to claim 6. Additionally, claim 9 includes the distinguishing feature of listing the amount of money owed by the first ISP to the second ISP for time that a second user was connected to the Internet through a second system. Hayes does not disclose such an arrangement between a first and second ISP. Claim 11 includes the distinguishing feature of transmitting funds from the second ISP to a settlement operator and transmitting funds from the settlement operator to the first ISP. Hayes does not disclose such an arrangement between a first and second ISP and a settlement operator.

Claim 12 of the present invention claims an apparatus comprised of first, second and third server means, first transmission means, first storage means and report generation means. The first server means is for tracking an amount of time a first user is connected to the Internet through a first system operated by a first Internet Service Provider. The first transmission means is connected to the first server means for transmitting the first user record over the Internet. The second server means is for receiving the first user record from the first server means and for transmitting a second user record over the Internet. The third server means is located at a different physical location than the second server means and receives the second user record from the second server means. The report generation means is associated with the third server means and generates a report from the second user record that includes at least the amount of time the first user was connected to the Internet through the first system.

Comparing claim 12 of the present invention to the *Network World I* and *Network World*

// references, and to Hayes, shows that there are several differences between the two inventions. First, in claim 12 the first server tracks Internet usage of a first user who does not have an account with the first ISP who operates the first system. As was explained previously with respect to claims 1 and 6, Hayes does not disclose such a system.

Second, claim 12 includes a second server located at a different location than the first server for receiving the user record. As was explained previously with respect to claim 6, the second server in claim 12 allows the user record to be stored at a physical location away from the first system operated by first ISP. This allows the operator of the third server to control the storage of the user record. For all of these reasons, applicants submit that claim 12 is patentable over the Network World Journal in view of Hayes. Claims 13 and 16-17 are dependent on claim 12 and are therefore patentable over the Network World Journal in view of Hayes for the same reasons given above with respect to claim 12.

For all of these reasons, applicants respectfully submit that pending claims 1-9, 11-13, 16-18 and 20 are in condition for allowance. If a telephone conference with the applicants' attorney would help resolve any remaining issues, please contact the applicants' attorney at the number listed below.

Respectfully submitted,



Donald J. Pagel
Reg. No. 32,832

April 3, 2003
Law Office of Donald J. Pagel
586 N. First Street, Suite 207
San Jose, CA 95112
(408) 995-0881